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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,348	09/26/2005	Eric F Bernstein	BERN0073US.NP	7761
26259 7590 05/13/2010 LICATA & TYRRELL P.C. 66 E. MAIN STREET MARLTON, NJ 08053				
EXAMINER HUANG, GIGI GEORGIANA				
ART UNIT		PAPER NUMBER		
1612				
NOTIFICATION DATE		DELIVERY MODE		
05/13/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

poreilly@licataandtyrrell.com

Office Action Summary

Application No.

10/541,348

Applicant(s)

BERNSTEIN, ERIC F

Examiner

GIGI HUANG

Art Unit

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application

1. The response filed February 4, 2010 has been received, entered and carefully considered. The response affects the instant application accordingly:
 - a. Claim 1 has been amended.
2. Claim 1 is pending in the case.
3. Claim 1 is present for examination.
4. The text of those sections of title 35.U.S. Code not included in this action can be found in the prior Office action.
5. All grounds not addressed in the action are withdrawn or moot.
6. New grounds of rejection are set forth in the current office action.

New Grounds of Rejection

Due to the amendment of the claims the new grounds of rejection are applied:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Ko et al. (The Combined Effect of Brain-Derived Neurotrophic Factor and a Free Radical Scavenger in Experimental Glaucoma).

Ko et al. teaches a method of treating glaucoma (intraocular pressure) comprising administering brain-derived neurotrophic factor (BDNF) and the free radical scavenger N-tert-butyl-(2-sulfophenyl)-nitron(S-PBN, a stable nitroxide free radical) in hypertensive eyes. The survival of the retinal ganglion cells with BDNF was moderate, with S-PBN alone was not significant, and the combination of both was significant and synergistic (see full document, specifically Abstract, Results, and Discussion).

All the critical elements are taught by the cited reference and thus the claims are anticipated.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Meyerhoff et al. (WO 00/74672) .

Meyerhoff et al. teaches a method of treatment for damage to the retina with the administration of phenyl nitrones (stable nitroxide free radical) and dihydrolipoic acid or alpha-lipoic acid (Abstract). The phenyl nitrones include PBN (α -Phenyl-N-tert-butyl-nitron- stable nitroxide free radical) and N-tert-butyl-(2-sulfophenyl)-nitron (SPBN- stable nitroxide free radical, Page 3 second paragraph). The conditions expressly taught for treatment include glaucoma (Page 6 first paragraph, Claim 2, 4, 9-10, 12-22)

All the critical elements are taught by the cited reference and thus the claims are anticipated.

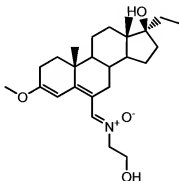
9. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Nathanson (U.S. Pat. 5500230).

Nathanson teaches a method of treatment for glaucoma with the administration of nitroglycerine or a nitrite (both stable nitroxide free radicals-Abstract). The nitrites include minoxidil (a stable nitroxide free radical, Abstract, Examples 13-16, claim 5-10).

All the critical elements are taught by the cited reference and thus the claims are anticipated.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Petrow et al. (U.S. Pat. 5646136).

Petrow et al. teaches a method of treating ocular hypertension (glaucoma) comprising administering certain steroids with angiostatic activity (Abstract, claim 1). Certain steroids are claimed and exemplified including N-(2-hydroxyethyl)-.alpha.-(17.beta.-hydroxy-3-methoxypregna-3,5-dien-6-yl) nitron (Example 19-a stable nitroxide free radical) where its use for glaucoma treatment is expressly taught and



immediately envisioned. Its structure is

All the critical elements are taught by the cited reference and thus the claims are anticipated.

Response to Arguments

11. In regards to Applicant's argument to Ko et al. as not teaching a stable nitroxide free radical, this is not persuasive as S-PBN is also a known nitroxide/nitrone and a nitrogen spin agent wherein the rejection is maintained.

Conclusion

12. Claim 1 is rejected.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GIGI HUANG whose telephone number is (571)272-9073. The examiner can normally be reached on Monday-Thursday 8:30AM-6:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fredrick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GH
/Zohreh A Fay/
Primary Examiner, Art Unit 1612